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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,825	05/10/2001	Todd A. Schelling	10559-416001/P10374	6463

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EXAMINER

SCHUBERT, KEVIN R

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,825

Applicant(s)

SCHELLING ET AL.

Examiner

Kevin Schubert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claims 1-23 have been considered.

Specification

The Specification is missing the following component(s):

Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

Submission of an appropriate Summary of the Invention is required.

Claim Objections

Claims 5-22 are objected to because of the following informalities: the claims are misnumbered.

The second claim #5 has been renumbered claim #7. Subsequent claims have been renumbered accordingly. Appropriate correction is required.

Claim 16 is objected to because of the following informalities: claim 16 is identical to claim 15. Subsequent claims have been renumbered accordingly, as claim 17 is now claim 16 up until the final claim 24 which is now claim 23.

Claims 9-16 and 18-23 are objected to because of the following informalities: the claims depend on the wrong claim. Claims 9-13 and 15-16 should depend on claim 8 instead of claim 6. Claim 14 should depend on claim 13. Claims 18-19 and 21-23 should depend on claim 17. Claim 20 should depend on claim 19.

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Claim 13 is objected to because of the following informalities: the claim contains a grammatical error. The phrase "the at least one of" should be rewritten "at least one of". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4,6-14,16-20, and 22-23 are rejected under 35 U.S.C. 102(b) as being unpatentable by Tello, U.S. Patent No. 6,463,537.

As per claims 1 and 17, the applicant discloses the following method which is anticipated by Tello:

- a) receiving, at a BIOS, a message from an authorized party (Col 4, lines 57-67; Col 5, line 1);
- b) authenticating the message (Col 4, lines 57-67; Col 5, line 1);
- c) controlling a state of a feature of a system resource, using the BIOS, according to the message (Col 4, lines 57-67; Col 5, line 1);

As per claims 2,12, and 18, the applicant discloses the method of the independent claim, which is anticipated by Tello (see above), with the following limitation which is also anticipated by Tello:

Further comprising verifying an identifier in the message against a unique system identifier of the system (Col 9, lines 20-30);

As per claims 3 and 19, the applicant discloses the method of the independent claim, which is anticipated by Tello (see above), with the following limitation which is also anticipated by Tello:

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Further comprising writing the message into a secure non-volatile location (Col 4, lines 57-67; Col 5, line 1);

The applicant should note that the secure non-volatile location where the message of which computing devices to be used is written is the smart card.

As per claims 4, 14, and 20, the applicant discloses the method of claims 3 and 19, which are met by Tello (see above), with the following limitation which is also anticipated by Tello:

Wherein the secure non-volatile location comprises a remote storage (Col 5, lines 15-19);

The applicant should note that the secure non-volatile location where the message of which computing devices to be used is written is the smart card which is remote storage.

As per claims 6, 16, and 22, the applicant discloses the method of the independent claim, which is met above, with the following limitation which is also anticipated by Tello:

Further comprising loading and executing content of the message using the BIOS at run-time (Col 23, lines 36-55);

As per claim 8, the applicant discloses the following system which is anticipated by Tello:

- a) a system resource having controllable features (Col 4, lines 57-61);
- b) a non-volatile memory that stores a BIOS, the BIOS being adapted to receive a secure message from an authorized party for controlling at least one of the features (Col 4, lines 61-67; Col 5, line 1);

As per claim 9, the applicant discloses the system of claim 8, which is anticipated by Tello (see above), with the following limitation which is also anticipated by Tello:

Further comprising a write-once non-volatile unit for storing a public key accessible by the BIOS (Col 15, lines 6-13);

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As per claim 10, the applicant discloses the system of claim 8, which is anticipated by Tello (see above), with the following limitation which is also anticipated by Tello:

Wherein the BIOS includes authentication circuitry for authenticating the secure message with a public key (Col 15, lines 6-13);

As per claim 11, the applicant discloses the system of claim 8, which is anticipated by Tello (see above), with the following limitation which is also anticipated by Tello:

Further comprising a write-once non-volatile unit for storing a unique system identifier accessible by the BIOS (Col 9, lines 20-30);

As per claim 13, the applicant discloses the system of claim 8, which is anticipated by Tello (see above), with the following limitation which is also anticipated by Tello:

Further comprising a secure non-volatile location for storing at least one of the optional features to be enabled, the location being readable and writable by the BIOS (Col 4, lines 57-67; Col 5, line 1; Col 25, lines 9-14);

The applicant should note that the claim discloses that the location is readable and writable by the BIOS. Tello discloses that "verifying the identity of authorized users through smart card identification [is] performed at the BIOS level" (Col 4, lines 62-63). In addition to reading the data, the security engine, which is controlled by the BIOS "writes the security parameters and vendor information to the Key Management area of the EEPROM of the user smart card" (Col 25, lines 11-13);

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

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subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5,7,15,21, and 23 are rejected under 35 U.S.C. 103(a).

Claims 5 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tello in further view of Merkin, U.S. Patent No. 6,584,561.

As per claims 5 and 21, the applicant discloses the limitations of claim 1, which is met by Tello (see above), with the following limitation which is met by Merkin:

Further comprising slicing the content of the message into an execution path of the BIOS (Col 2, lines 27-34);

Tello discloses all the limitations of independent claim 1. However, Tello fails to disclose splicing the content of the message. Merkin discloses a boot system similar to Tello's system with the main difference that Merkin's system revolves around a CD boot while Tello's system revolves around a smart card boot. Merkin discloses that the message received from the CD includes identification data and boot software. Once the data has been authenticated, the boot software is split from the rest of the message and alone "the boot software is copied back to the execution part" (Col 2, lines 20-21). It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Merkin with those of Tello and splice the content of the message into an execution path of the BIOS because only the necessary data needs to be sent to the execution path of the BIOS.

Claims 7,15, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tello in further view of Qureshi, U.S. Patent No. 6,769,059.

As per claims 7,15, and 23, the applicant discloses the limitations of claim 1, which is met by Tello (see above), with the following limitation which is met by Qureshi:

Further comprising updating a feature set of the BIOS according to the message (Col 1, lines 34-42);

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Tello discloses all the limitations of independent claim 1. However, Tello fails to disclose updating a feature set of the BIOS according to the message. Qureshi discloses a secure method for updating a portion of the BIOS, the video BIOS. Qureshi discloses that updating a portion of the BIOS is a more efficient way of making an update without having to update the entire BIOS. By the same token, the applicant claims limiting a feature set or portion of the BIOS without having to update the entire BIOS. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Qureshi with those of Tello and update a portion of the BIOS.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Caldwell
Andrew Caldwell